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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/449,738	11/26/1999	AKIHIKO SATO	35.C14040	6641

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EXAMINER

VIDA, MELANIE M

ART UNIT PAPER NUMBER

2697

DATE MAILED: 08/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/449,738

Applicant(s)

SATO, AKIHIKO

Examiner

Melanie M Vida

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 November 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description:

- a. The step numbers, S1701-S1705 as described in the specification is not found in drawing 17, (pg. 45, line 15 through page 46, line 15). *mr*

- b. The item labeled (250) in drawing 2, but it appears in the specification that it should be labeled (205), (pg. 7, line 10). *mr*

- c. The recording material (7) described in the specification on page 9, line 15, is not shown in drawing 2. *mr*

- d. The item labeled (9g) in figure 2, is not found in the specification, (pg. 10, line 6). *mr*

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description:

- a. The items labeled (32), (30), (5e), (9a), (9e), (5d), (9f), (9b), as shown in drawing 2, are not found anywhere in the specification, (pg. 6, line 16 through pg. 11, line 19). *mr*

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b. The items labeled (51), appears in figure 2, but it is (5i) for “cam follower” in the specification, (pg. 11, line 14).

A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

4. The disclosure is objected to because of the following informalities:

- a. The word “example3” is misspelled, (pg. 17, line 19). ^{mv}
- b. The word “taster” is misspelled, (pg. 18, line 1). ^{mv}
- c. The word “mage” is misspelled, (pg. 25, line 17). ^{mv}

Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the

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reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. **Claims 1-5, 18** are rejected under 35 U.S.C. 102(e) as being anticipated by Rhoads, USP 5,822,436, (hereinafter, Rhoads).

Regarding, **claim 1**, Rhoads teaches a photo-duplication kiosk, which reads on “an image processing apparatus”, (col. 76, lines 6-14). Further, Rhoads teaches that devices in the photo-duplication kiosk contain a processor to process the memory data in order to detect the presence of copyright data steganographically encoded in the data, which reads on a “detector means for detecting information relating to invisible copyright from image data which is input”, (col. 76, lines 15-20). Rhoads inherently teaches that the processor is a “control means for controlling the print of said image data according to information relating to said detected copyright, as evidenced by the statement, “If such data is detected, the print-writing is interrupted.” (col. 76, line 19-20).

Regarding, **claim 2**, Rhoads teaches that copyright data is steganographically encoded in the data, which reads on “the information relating to said invisible copyright is digital watermark information”, (col. 76, lines 17-19).

Regarding, **claim 3**, Rhoads teaches that print-writing is interrupted if the invisible copyright information is detected to assure that the machine is not in violation of a photographer’s copyright, which reads on “the control means prohibits the output of said image data to a printer which performs said print”, (col. 76, lines 19-20; lines 25-31).

Regarding, **claim 4**, Rhoads teaches that a photographic duplication kiosk can be instructed by the embedded information to disable the copying function of the kiosk, which reads

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on “control means prohibits the output of said image data to a printer which performs said print”, (col. 1, lines 59-63).

Regarding, **claim 5**, Rhoads teaches a print-writing is interrupted, which reads on “control means outputs a control signal which gives said image data to a printer which performs said print to prohibit the print of said image data”, (col. 76, lines 19-20; lines 25-31).

Regarding, **claim 18**, please refer to the like teachings of claim 1.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claim 6** is rejected under 35 U.S.C. 103(a) as being unpatentable over Rhoads, USP 5,822,436, as applied to claim 1 above, and further in view of Kojima et al. JP 2000-253241, hereinafter, (Kojima).

Regarding, **claim 6**, Rhoads teaches the image processing apparatus according to claim 1, but fails to expressly disclose an “identifying means for identifying a password embedded in said image data, wherein said control means permits the print of an image which corresponds to said image data when the same password as said password is inputted”.

However, Kojima teaches of a printing information analysis circuit (15), that always monitors printing data transferred to a printer, and password information buried by electronic watermark technology, which reads on “an identifying means, (see solution, line 1-8). This circuit monitors printing data (11) such as character string information, picture pattern

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information, code information and password information buried by electronic watermark technology, which reads on “for identifying a password embedded in said image data”, (see solution, lines 1-8). Further, the printing information analysis circuit (15) outputs a stop instruction (151) to a printer driver for stopping the transfer of portion of printing data information which correspond to copy inhibition information (14), which reads on “control means permits the print of an image which correspond to said image data, when the same password”, (see solution, lines 8-13). Further, it has the function of user authentication in the prevention release setting circuit (16), and can set it from a network (100), which reads on “as said password is inputted”, (see solution, lines 8-13; and detailed description; paragraph 0078).

At the time the invention was made it would have been obvious to a person of ordinary skill in the art to modify Rhoads image processing apparatus with Kojima’s printing information analysis circuit.

One of ordinary skill in the art would have been motivated to do use a printing information analysis circuit in order authenticate a password subsequent to printing image data.

10. **Claims 7-8** is rejected under 35 U.S.C. 103(a) as being unpatentable over Rhoads, USP 5,822,436 as applied to claim 1 above, and further in view of well known prior art (MPEP 2144.03).

Regarding, **claim 7**, Rhoads teaches the image processing apparatus according to claim 1, but fails to specifically disclose an “ID detecting means”, “inputting means for inputting a password”, and receiving means for sending said ID information and a password to an author’s side device to receive information of print permission for said image information”.

The examiner takes Official Notice of the fact that it is well known in the image processing and computer science art to use a graphical interface and software to detect an ID associated with a HTML, XML, or Java applet, password tag, after a user has inputted a password through a graphical user interface (GUI). Further, it is well-known to have a receiving means such as a web-server to received ID information entered into the GUI and transmitted to the server-side computer from the client computer. Finally, it is well-known to authenticate a password on a server side, which reads on the “author’s side device” to compare to a stored password in an restricted file, with the transmitted password.

It would have been obvious to anyone of ordinary skill in the art at the time of the invention to modify Rhoads image processing apparatus according to claim 1, with a ID detecting means, inputting means, and receiving means.

One of ordinary skill in the art would have been motivated to use a ID detecting means, inputting means, and receiving means, in order to provide limited access to copyright information for paying customers.

Regarding, **claim 8**, it is further well-known in the image reproduction art, and the computer science fields to use software methods or functions, which reads on “instructing means”, for authenticating a user password, on the server computer to permit the subsequent transmission of the requested image data to the client computer for printing, which reads on “for instructing acceptance for accounting for print using said image data to an author’s side device wherein said control means permits the print of said image data in response to said instruction”.

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11 **Claims 9-12, 17, and 19** are rejected under 35 U.S.C. 103(a) as being unpatentable over Schreiber et al. USP 6,298,446 B1, (hereinafter, Schreiber).

Regarding, **claim 9**, as shown in figure 1, Shreiber illustrates, a system for copyright protection of digital images for use within a distributed server-client computer environment, which reads on “an image processing apparatus”, (col. 9, lines 17-22). Shreiber teaches of an HTTP filter (114) that determines the protection status of each image referenced within the web page (104), using protection status database (118), which reads on “detecting means”, (col. 9, lines 61-63). The protection status database (118) may reside on a different computer other than the server computer (100), and a substitute data processor is capable of preventing a user of client computer (106) from copying an image that is displayed by web browser (112), which reads on “obtaining means”. Shreiber teaches that a reference to a graphic object specifies the network address of the computer containing the graphic object, such as an IP address, which reads on “for obtaining an address of a device, which holds a data list relating to said image data”, (col. 6, lines 37-41). The user may attempt to print an image, but a substitute image may be printed, instead, as a watermarked version of the original image, derived from composing watermarks over the image, which reads on “from said detected digital watermark information”, (col. 7, lines 30-35; lines 45-50; lines 53-57). The server computer generates a modified web page, such that the protected images are substituted with references to substitute data, which reads on “receiving means for receiving data list from said device according to said address”, (col. 11, lines 35-37). The client computer receives the modified web page, which reads on “receiving means for receiving a data”, (col. 11, lines 49-51). As shown in figure 2, step 206, the user requests to open a web page using the web browser, and the client computer issues an HTTP

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request for the web page to a web server on the server computer, which reads on “data selected by a user”, (col. 11, lines 19-26). Further, a user interface (308), displays a list of folder names, and image file names for the files in file system (304), which reads on “data selected by a user from said image data list”, (col. 12, lines 38-44).

Shreiber does not expressly teach “detecting a digital watermark contained in image data”.

However, Shreiber discloses that prior-art techniques protect digital images by embedding hidden messages within pixel data for identifying protected images, and tracks there distribution over the Internet to monitor potential copyright infringement, which reads on “detecting a digital watermark contained in image data”, (col. 1, lines 64-67).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify Shreiber’s system for copyright protection with prior-art techniques for detecting watermarks in image data over the Internet.

One of ordinary skill in the art would have been motivated to detect watermarks in image data in order to monitor copyright infringement over the Internet, given the express suggestion of Schreiber, (col. 1, lines, 65-67).

Regarding, **claim 10**, Schreiber teaches of data being, for example, the invention was described with respect to digital images but could also apply copyright protection of other forms of multi-media referenced in web pages as well, such as audio files, video files and slide shows, which reads on “said data is an image, a speech, or a movie”, (col. 32, line 63 through col. 33, line 4).

Regarding, **claim 11**, Schreiber discloses that CyberSales Solution provides locking and unlocking functionality so that content can be securely previewed by consumers, electronically purchased and redistributed, and it protects the content in an initial transaction and in subsequent information pass-along, which reads on “data list writes therein a plurality of data pieces and charge for said plurality of data pieces”, (col. 1, lines 38-45).

Regarding, **claim 12**, please see the like teachings of claim 11, and further where Scheiber discloses that CyberSales Solution handles secure transactions, which inherently reads on “inputting the number of a cash card of said user”, (col. 1, lines 45-46).

Regarding, **claim 17**, Schreiber teaches that a reference to a graphic object specifies the network address of the computer containing the graphic object, such as an IP address, and a web browser encounters the references to graphic objects, which reads on “said address comprises a plurality of addresses”, (col. 6, lines 37-41; lines 44-46). Further, Schreiber teaches that client computers (106) access web pages stored on server computers (100) over the internet, which reads on “data receiving means”, (col. 9, lines 46-50). Further, images referenced in web pages (104) may reside on server computer (100), as well as on other computers, which reads on “receives data list from a plurality of devices”, (col. 9, lines 27-31).

Regarding, **claim 19**, please refer to the like teachings of claim 9.

12. **Claims 13-16** are rejected under 35 U.S.C. 103(a) as being unpatentable over Schreiber et al. USP 6,298,446 B1, as applied to claim 9 above, and further in view of well known prior art (MPEP 2144.03).

Regarding, **claims 13-16**, Schreiber teaches the image processing apparatus according to claim 9, and further that copyright protection may be applied to other forms of multi-media, such as audio files, video files, slide shows, (col. 32, line 65 through col. 33, line 3).

Schreiber fails to specifically disclose the following:

“data is data of another produce of a painter who has written said image data”, (claim 13),

“data is data of another produce of a composer who has written a musical note corresponding to said image data”, (claim 14),

“data is data of another produce of an author who has written a book according to said image data”, (claim 15),

“data is data of another produce of a photographer who has taken a photograph corresponding to said image data”, (claim 16).

The examiner takes Official Notice of the fact that it is well known in the art to provide copyright protection to painter who has written image data, a composer who has written a musical note, a written book, and a photograph.

It would have been obvious to anyone of ordinary skill in the art at the time of the invention to use copyright protection for all kinds of multi-media in order to prevent copyright infringement of all kinds of digital multimedia.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Proceedings of the European Conference on Multimedia Applications, Services, and techniques, Louvain-La-Neuve, Belgium, May 1996.

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McKinley et al. US 2002/0120849 A1, watermark detector types

Rhoads, US 5,832,119 a method for controlling systems using signals embedded in empirical data.

Rhoads, US 6,122,403 a steganographic decoding for copyright protection in photo duplication kiosks.

Rhoads, US 5,862,260, an automated system that checks networked computers for watermarked audio, video, or image data over the Internet.

Rodriquez et al. US 2003/0050961 A1, a method for control of displaying Internet data.

Rhoads et al. US 2002/0012443 A1 controlling a device with watermark detector.

Takaragi USP 6,366,685, adding copyright information to image data.

Ginter et al. US 2003/0105721 A1 a system and method for secure transaction and electronic rights protection.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie M Vida whose telephone number is (703) 306-4220. The examiner can normally be reached on 8:30 am 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on (703) 305-4863. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-6743 for regular communications and (703) 308-6743 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

mmv
MMV
July 18, 2003

KA Williams
Kimberly A. Williams
Primary Examiner
Technology Center 2600

Melanie M Vida
Examiner
Art Unit 2697